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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,903	02/04/2004	Clay Fisher	Sony-05800	3872
36813	7590	09/12/2006	EXAMINER	
O'BANION & RITCHIE LLP/ SONY ELECTRONICS, INC. 400 CAPITOL MALL SUITE 1550 SACRAMENTO, CA 95814			REAGAN, JAMES A	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/771,903	FISHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	James A. Reagan	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 24 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____.   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION**

**Status of Claims**

1. This action is in reply to the application filed on 24 February 2004.
2. Claims 1-30 have been examined.

**Information Disclosure Statement**

3. The Information Disclosure Statements filed have been considered. Initialed copies of the Form 1449 are enclosed herewith.

**Double Patenting**

4. Claims 1-30 of this application conflict with claims 1-30 of Application No. 10/771,903. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.
5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

6. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
7. Claims 1-30 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-30 of copending Application No. 10/771,903. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

#### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
9. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bandini (US 2002/0169954 A1) in view of Kyler (US 2002/0174102 A1).

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or

part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 4, 14, 15, 24, and 30:**

Bandini, as shown discloses the following limitations:

- *receiving content for use in an application* (see at least paragraphs 0007 and 0030-3002);
- *reviewing the content* (see at least paragraph 0007 and 0030-0032);
- *automatically sequestering the content from the application based on the reviewing* (see at least paragraph 0064);
- *forming a reason associated with the sequestering the content* (see at least paragraph 0032);

Bandini does not specifically disclose *storing the content in an off-line storage device*. However, Bandini does disclose quarantining infected files, which is equivalent to isolating the file in an offline environment. In addition, Kyler discloses a storage policy regarding filtered files which should be quarantined or deleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini to include an offline storage facility and to combine with Kyler because, "Organizations are increasingly relying on e-mail for the transfer of critical files such as purchase orders, sales forecasts, financial information, and contracts, both within the organization and, increasingly, with other organizations via the Internet. In this setting, these files are now tangible information assets that must be protected" (Bandini, paragraph 0003).

**Claim 2:**

With regard to the limitation of *attaching the reason with the content*, see at least Bandini paragraph 0044 (notification actions 616 cause the sending of one or more e-mail notifications when a given policy is triggered).

**Claims 3 and 16:**

With regard to the limitation of *the content includes one of a photograph, music, a document, and a video*, Bandini discloses an email document as shown above.

**Claim 5:**

With regard to the limitation of *the reason provides an explanation of the sequestering the content*, see at least Bandini paragraph 0044 (notification actions 616 cause the sending of one or more e-mail notifications when a given policy is triggered).

**Claim 6:**

With regard to the limitation of *the sequestering the content prevents the content from being accessed by the application*, see at least Bandini paragraph 0007, 0030-0032, and 0064). In addition, Kyler discloses a storage policy regarding filtered files which should be quarantined or deleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini to include an offline storage facility and to combine with Kyler because, "Organizations are increasingly relying on e-mail for the transfer of critical files such as purchase orders, sales forecasts, financial information, and contracts, both within the organization and, increasingly, with other organizations via the Internet. In this setting, these files are now tangible information assets that must be protected" (Bandini, paragraph 0003).

**Claims 7 and 17:**

With regard to the limitation of *the sequestering the content prevents the content from being accessed by a submitter of the content through the application*, see at least Bandini paragraph 0007, 0030-0032, and 0064). In addition, Kyler discloses a storage policy regarding filtered files which should be quarantined or deleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini to include an offline storage facility and to combine with Kyler because, "Organizations are increasingly relying on e-mail for

the transfer of critical files such as purchase orders, sales forecasts, financial information, and contracts, both within the organization and, increasingly, with other organizations via the Internet. In this setting, these files are now tangible information assets that must be protected" (Bandini, paragraph 0003).

**Claims 8, 18, and 28:**

With regard to the limitation of *storing format information associated with the content in an off-line storage device*, see at least Bandini paragraph 0007, 0030-0032, and 0064). In addition, Kyler discloses a storage policy regarding filtered files which should be quarantined or deleted. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bandini to include an offline storage facility and to combine with Kyler because, "Organizations are increasingly relying on e-mail for the transfer of critical files such as purchase orders, sales forecasts, financial information, and contracts, both within the organization and, increasingly, with other organizations via the Internet. In this setting, these files are now tangible information assets that must be protected" (Bandini, paragraph 0003).

With regard to format, see at least Bandini paragraph 0033.

**Claim 9:**

With regard to the limitation of *the sequestering the content further comprises removing the content from the application*, see at least Bandini paragraph 0007, 0030-0032, and 0064). In addition, Kyler discloses a storage policy regarding filtered files which should be quarantined or deleted. The combination of Bandini/Kyler does not specifically disclose cleaning the email message by removing the virus. However, the Examiner takes **Official Notice** that it is old and well known in the virus protection arts to sterilize documents by removing malicious code that may be attached to the document. Removing the codes allows the message or file to be safely reinserted into the application without interruption to the user.

**Claims 10 and 20:**

With regard to the limitation of *the application includes one of an electronic photo album application, a music sharing application, and a file sharing application*, Bandini discloses an email document as shown above.

**Claims 11, 21, 27, and 29:**

With regard to the limitation of *notifying a submitter of the content that the content is not acceptable*, see at least Bandini paragraph 0044 (notification actions 616 cause the sending of one or more e-mail notifications when a given policy is triggered).

**Claims 12 and 22:**

With regard to the limitation of *returning the content and format information associated with the content to a submitter*, see at least Bandini paragraph 0007, 0030-0032, and 0064, and Figure 6a item 622).

**Claims 13 and 23:**

With regard to the limitation of *restoring the content and format information associated with the content to the application*, see at least Bandini paragraph 0007, 0030-0032, and 0064, and Figure 6a item 622; and Figure 7, item 714).

**Claim 19:**

The combination of Bandini/Kyler discloses formatting information as shown above. The combination of Bandini/Kyler does not specifically disclose *the format information includes one of location information of the content, background color information for the content, and caption information describing the content*. However, the Examiner takes **Official Notice** that it is old and well known in the computer arts to format documents and files in a manner which is necessary for users and systems.

**Claim 25:**

With regard to the limitation of *a capture module configured to identify the content*, see at Bandini least paragraphs 0007 and 0030-0032.

**Claim 26:**

With regard to the limitation of *the review module determines the unacceptable content by criteria established through a terms of service agreement*, see at Bandini least paragraphs 0007 and 0030-0032.

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Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** whose telephone number is **571.272.6710**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **571.272.6712**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**571-273-8300** [Official communications, After Final communications labeled "Box AF"]

**571-273-8300** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window:**

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**JAMES A. REAGAN**

Primary Examiner

Art Unit 3621

22 August 2006

**JAMES A. REAGAN**  
**PRIMARY EXAMINER**

